

REMARKS/ARGUMENTS

Rejection of Claims 1, 6, 8 and 10 Under 35 U.S.C. §102(b) as Being Anticipated by Monk

The Examiner contends that the above-referenced claims are anticipated by the Monk patent. The Examiner has identified the key 16 of Monk as corresponding to the “desired article” of Claim 1. Additionally, the Examiner has identified the post 18 of Monk with the “extended post” of Claim 1. Further, the Examiner has identified the traverse hole 38 of Monk with the “aperture” of Claim 1, and the plate member 12 of Monk with the “shoulder” of Claim 1.

Regarding Claim 1, Applicant has amended Claim 1 to further recite that:

- (a) The desired article has an interior side *facing toward an interior volume defined substantially by said desired article, said interior volume for placing one or more body portions or objects therein;*
- (b) The desired article has an exterior side *facing substantially away from the interior volume;*
- (c) *When the device is attached to the desired article,* the shoulder of the device is positioned on the interior side of the desired article;
- (d) The extended post *includes at least an outwardly extending portion that extends outwardly from the exterior side of the desired article;*
- (e) There is a “first portion” of the device for: *“connecting between at least a portion of said shoulder and said outwardly extending portion, for supporting said device on said desired article, wherein the user can reversibly attach different items to said device by inserting for each of said different items an attachment in said aperture provided in said outwardly extending portion.”*

To constitute anticipation, all material elements of the claim must be found in one prior art source. In re Marshall, 198 USPQ 344 (CCPA 1978); In re Kalm, 154 USPQ 10 (CCPA 1967). It is believed that no prior art discloses or suggests the above limitations (a) through (e) in combination with the other recited components of Claim 1. In particular, it appears that:

- (i) Monk does not disclose his key-retaining device 10 being supported by a “desired article” wherein this article substantially defines an interior volume

for placing one or more body portions or objects (e.g., the interior volume of a pair of pants, of a belt about a person, of a purse, or luggage);

- (ii) Monk does not disclose that the “shoulder” (i.e., the plate member 12) of his key-retaining device 10 is positioned on the “interior side” of the desired article, wherein this interior side faces *toward* the interior volume of the desired article such that this volume is for placing one or more body portions or objects therein; and
- (iii) Monk does not disclose that “the user can *reversibly attach different items* to said device by inserting said different items in said aperture provided in said outwardly extending portion.”

Accordingly, it is believed that Claim 1 is patentable.

Regarding Claims 6 and 8 these claims are patentable due to their dependence on Claim 1.

Regarding Claim 10, this claim has been amended to recite, e.g., a “contact portion” for contacting the desired article which supports the key ring holder device, wherein at least one of the following hold:

- (a) the contact portion includes a portion of the length of the post that extends through the desired article wherein said article supports said device *regardless of an orientation of said desired article about said length*, and
- (b) the contact portion includes at least a portion of first and second opposed surfaces of the shoulder such that a portion of desired article is secured between said portion of said first surface and said portion of said second surface.

Additionally, Claim 10 now recites that the desired article “is portable with the user and includes at least a portion which conforms to a part of the user’s body contacting said desired article”. It is believed that none of the above limitations are disclosed or suggested by Monk or any other prior art known. Accordingly, the combination of such limitations is also not shown in the prior art. Thus, it is believed that Claim 10 is patentable.

Rejection of Claim 2 Under 35 U.S.C. §103(a) as Being Unpatentable Over Monk in view of Heller

The Examiner rejects Claim 2 in view of a combination of Monk and Heller. Applicant believes that such combination is improper and furthermore that even if such combination were proper, one of ordinary skill in the art would not arrive at the presently claimed invention.

Specifically, the Examiner contends that Monk recites the limitations of Claim 1 and also that a washer can fit over a post for securing a device to a desired article. The Examiner admits that Monk does not disclose the desired article to be selected from the group consisting of a garment, a belt, a purse and luggage. The Examiner contends, however, that Heller discloses a belt plate with an attachment that may be used to hold keys. The Examiner therefore concludes that it would have been obvious to one of ordinary skill in the art at the time of the present invention to modify Monk as taught by Heller for the purpose of facilitating easy access to the keys for a person wearing a belt. Applicant respectfully disagrees for the reasons as set forth below.

Applicant submits that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. *Ex parte Kranz*, 19 USPQ 2d 1216, 1218 (BPAI 1981). It appears that in the present case the only suggestion for the Examiner's combination of the teachings in Monk and Heller improperly stems from the Applicant's own disclosure and not from the cited references themselves. At best, the Examiner's comments regarding obviousness appear to amount to an assertion that one of ordinary skill in the relevant art would have been able to arrive at Applicant's invention because they would have had the necessary skills to carry out the requisite steps to make the combination of disclosed features. This is an inappropriate standard for obviousness. In brief, neither of the references alone or in combination provide an impetus necessary to cause one of ordinary skill in the art to combine the teachings of the references in the way the Examiner has done.

It is well established that an evaluation of the obviousness or non-obviousness of claims must not be made with the benefit of hindsight using the present application as a blueprint to

reconstruct the claimed invention from the references. See *Interconnect Planning Corporation v. Feil*, 227 USPQ 543 (Fed.Cir. 1985). To draw on hindsight knowledge of the patented invention, when the prior art does not contain or suggest that knowledge, is to use the invention as a template for its own reconstruction -- an illogical and inappropriate process by which to determine patentability. *W.L. Gore & Assoc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983). Applicant submits that the Examiner's examination of the present invention should not be predicated upon the obviousness of particular features but rather, should be based upon an evaluation of the invention as a whole. The Examiner seems in essence to be stating that it would have been "obvious to try" modifying various parameters, and indeed selecting entirely different structural features having distinct identifying characteristics and used in completely different contexts, in order to produce the claimed invention. The Federal Circuit has provided clear direction with respect to arguments based on an "obvious to try" theory. The court has held that an "obvious to try" situation exists when a general disclosure may pique a scientists curiosity, such that further investigation might be done as the result of a disclosure, but the disclosure itself does not contain a sufficient teaching of how to obtain the desired result, or that the claimed result would be obtained if certain directions were pursued. *In re Eli Lilly & Co.*, 14 USPQ 2d 1741, 1743 (Fed.Cir. 1990). The court held, however, that "obvious to try" is not to be equated with obviousness under 35 U.S.C. §103. See *Gillette Co. v. S.C. Johnson & Son, Inc.*, 16 USPQ 2d 1923, 1928 (Fed.Cir. 1990). For the foregoing reasons, Applicant respectfully submits that because neither Monk nor Heller, alone or in combination, provide sufficient suggestions or teachings to direct one of ordinary skill in the art to make the present invention, Applicant respectfully requests that the Examiner withdraw all §103 rejections predicated upon such a combination.

Additionally, the Examiner has not provided any motivation for combining Monk and Heller. Moreover, by the Examiner's own analysis, the key 16 in Monk was identified as supposedly corresponding to the "desired article" of Claim 1 while in Heller the Examiner identifies the "desired article" as presumably the belt having front face 12. It is unclear as to how the combination of Monk and Heller are to be combined given the wholly different

identifications of the “desired article”. In particular, the Examiner’s identification of the “desired article” in Monk and Heller have different functions. In Monk the key 16 is the component that is *retained* by Monk’s key retaining apparatus, while the belt in Heller is the article by which Heller’s belt plated is *supported*. Thus, it appears that the resulting combination that the Examiner suggests would have the key 16 of Monk *surround* a user’s waist for *supporting* Monk’s key retainer thereon. It is submitted that this would make the Monk key retainer unsatisfactory for its intended purpose as per the following quote from the MPEP:

“If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)” MPEP 2143.01

If the Examiner persists with the present 103 rejection, it is respectfully requested that prior art be provided that suggests the combination of Monk and Heller wherein corresponding components in Monk and Heller are readily apparent to one of ordinary skill in the art. Additionally and importantly, note that in the recent CAFC court case of Jan. 18, 2002: *In re Sang Su Lee*, 61 USPQ2d 1430 (Fed. Cir. 2002), the United States *Court Of Appeals For The Federal Circuit*, *ruled that an obviousness determination may not substitute “common knowledge” of one skilled in the art for specific evidence that the prior art suggests an invalidating combination of references.* Note, that the CAFC ruled against both the patent examiner and the USPTO Board of Appeals in this case. Moreover, in *Al-Site Corp. v. VSI Int’l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999), the court stated that the skill level in the art *cannot* be relied upon to provide the suggestion to combine references.

Accordingly, it is believed that Claim 2 is patentable both due to the above reasoning as well as it’s dependence on Claim 1.

Rejection of Claims 3, 4 and 7 Under 35 U.S.C. §103(a) as Being Unpatentable Over Monk in View of Wu

The Examiner rejects the above-referenced claims over a combination of Monk in view of Wu. The Examiner admits that Monk does not disclose the post and the shoulder to be threadably connected together, however, the Examiner relies upon Wu's disclosure of a structure for a key chain in which a post is threadably connected to a shoulder for the purpose of allowing the post to be screwed into a plurality of main bodies. The Examiner therefore concludes that it would have been obvious to one of ordinary skill at the time of the invention to modify Monk as taught by Wu for the purpose of allowing the post to be detachable. Applicant respectfully disagrees. "The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art **suggested** the desirability of the modification." *In re Fritch*, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). That individual elements of the inventions are old can be found in the prior art is irrelevant. *Grain Processing Corp. v. American Maize Products Co.*, 5 USPQ2d 1788 (Fed. Cir. 1988). ***It is also well established that the Examiner should not be able to pick and choose individual elements from multiple references to recreate the invention.*** *Polaroid Corp. v. Eastman Kodak Co.*, 229 USPQ 561 (Fed. Cir.), *cert. denied*, 479 U.S. 850 (1996). In determining the scope and content of the prior art, and determining whether the prior art suggested the claimed invention, the references "must be read as a whole and consideration must be given where the references diverge and teach away from the claimed invention". *Akzo N.V. v. United States Int'l Trade Commission*, 1 USPQ2d 1241 (Fed. Cir. 1986) *cert denied*, U.S. 909 (1987); *Panduit Corp. v. Dennison Mfg. Co.*, 1 USPQ2d 1593 (Fed. Cir.), *cert denied*, 481 U.S. 1052 (1987).

Additionally, the identification of the "desired article" in Claim 1 as the key 16 of Monk makes it wholly unclear as to how one of ordinary skill in the art would be able to combine Monk and Wu to obtain the invention recited by Claims 3, 4 and 7. Accordingly, both for the reasoning supplied here, and due to Claims 3, 4 and 7 being dependent upon Claim 1, it is believed that these claims are patentable.

Rejection of Claim 5 Under 35 U.S.C. §103(a) as Being Unpatentable Over Monk in View of Budreck

The Examiner rejects Claim 5 over a combination of Monk and Budreck. While the Examiner admits that Monk does not disclose at least one aperture is a double counter-sunk hole, the Examiner contends that Budreck discloses a key ring holder with at least one double counter-sunk hole for key chain clearance purposes. The Examiner therefore concludes that it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Monk as taught by Budreck for the purpose of facilitating easy attachment and detachment of items through an aperture. Applicant respectfully disagrees. That the prior art may be modified to reflect features of claimed invention does not make the modification, and hence the claimed invention, obvious *unless desirability of such modification is suggested by prior art*. *In re Gordon*, 221 USPQ at 1127. The motivating suggestion must also be explicit. *Winner International Royalty Corporation v. Wang*, 48 USPQ2d 1139 (D.C, D.C. 1998) (“there must have been some explicit teaching or suggestion in the art to motivate one of even ordinary skill to combine such elements so as to create the same invention”). It is well established that an obviousness determination may not substitute for the factual inquiry of whether to combine references must be thorough and searching. *In re Sang Su Lee*, 61 USPQ2d 1430 (Fed. Cir. 2002). It must be based on objective *evidence* of record. *Id.* A showing of a suggestion, teaching or motivation to combine the prior art references is an “essential component of an obviousness holding”. *Brown and Williamson Tobacco Corp. v. Phillip Morris, Inc.*, 56 USPQ2d 1456, 1459 (Fed. Cir. 2000). As many courts have held, “the best defense against the subtle, but powerful attraction of a hindsight-based obviousness analysis is *rigorous application* of the requirement for a showing of the teaching or motivation to combine prior art references.” *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). It is abundantly clear that “there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. *In re Dance*, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998). Moreover, “particular findings must be made as to the reason the skilled artisan, with no

knowledge of the claimed invention, would have selected these components for combination in the manner claims." *In re Kotzab*, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000).

Accordingly, both for the reasoning supplied here, and due to Claim 5 being dependent upon Claim 1, it is believed that Claim 5 is patentable.

Rejection of Claim 9 Under 35 U.S.C. §103(a) as Being Unpatentable Over Monk in View of Forrest

The Examiner rejects Claim 9 in view of Monk and Forrest, while admitting that Monk does not disclose the shoulder having a cavity provided therein which permits the shoulder to fit over a button. The Examiner contends, however, that Forrest discloses a shoulder having a cavity which permits a shoulder to fit over a button for the purposes of securely fastening a key chain holder to an article. The Examiner therefore concludes that it would have been obvious to one of ordinary skill in the art to modify Monk as taught by Forrest for the purpose of eliminating the use of adhesives, holes and rivets to attach the key ring holder to an article. Numerous court cases regarding obviousness rulings have been cited above. It is believed that they apply to the present rejection as well. In particular, it appears that the resulting combination of Monk and Forrest would make the Monk key retainer unsatisfactory for its intended purpose. For example, since the Examiner has asserted that the "shoulder" in Claim 1 and presumably in Claim 9 is Monk's plate member 12, substituting or changing this plate member for providing the cavity 18 of Forrest results in the following problems:

- (a) The cavity 18 of Forrest is in a *flexible material* such as leather. Providing such a cavity in the *metal* plate member 12 of Monk would NOT permit the plate member 12 to fit over a button.
- (b) The key retainer of Monk includes a flexible wrapper 32 that *completely surrounds* the plate member 12. Thus, if by some means such a cavity for a button could be provided in the plate member 12, attaching the plate member 12 to such a button would not allow the closing of the flexible wrapper 32 about the plate member 12.

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Accordingly, for these reasons as well as the dependency of Claim 9 upon Claim 1, it is believed that Claim 9 is patentable.

New Claims

New Claims 11 through 15 are dependent upon Claim 10 and are believed to be patentable due to their dependence on Claim 10. Additionally, these claims are also believed to be patentable in that each recites a novel aspect of the invention not shown in the prior art.

New Claims 16 through 19 are dependent upon Claim 1 and are believed to be patentable due to their dependence on Claim 1. Additionally, these claims are also believed to be patentable in that each recites a novel aspect of the invention not shown in the prior art.

Applicant's counsel requests the courtesy of a telephone interview to discuss the present case in the event the Examiner has any further questions or concerns relating thereto. Applicant's counsel can be reached directly at (303) 863-2977.

It is believed that no fees are due in connection with the filing of this Amendment and Response as there are now 19 total claims, including 2 independent claims.

Attached hereto is a marked up version of the changes made to the specification and claims by the current amendment. The attached page is captioned **"Version With Markings to Show Changes Made."**

Respectfully submitted,

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M:\4690\1\PTO\AMD-01-Response to OA dated 5-7-02

VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE SPECIFICATION:

Please amend the paragraph beginning on page

Securement of the apparatus of the present invention to a garment or belt can be achieved in various different ways as will be appreciated by one of skill in the art. Preferably, however, the shoulder of the device can be attached directly to the garment or belt by a suitable adhesive and/or apertures can be provided in the shoulder for securing the shoulder to a garment or belt with rivets, thread, etc. A still further embodiment involves a rivet connection made possible by the shoulder being of a sufficient diameter such that it will not pass through an aperture in a grommet but which permits the post of the present invention to pass therethrough. To secure the post in such a grommet hole, various means can be employed. For example, the post may be maintained in a desired extended position, facilitating access to the at least one aperture in said post, simply due to the contact with a persons body or undergarment pressing outward against the shoulder. Alternatively, the device can be more firmly attached inside a grommet hole through the use of an exterior washer that fits over the post once the post has extended through the grommet hole. Thus, the shoulder is of sufficient circumference and diameter so that it cannot pass through a grommet hole, but wherein the post may extend through the hole, whereby a washer is placed over the post to secure it in place. One will appreciate that the washer placed over the post may be of different configurations, colors, etc. and is primarily intended as a cosmetic component. The washer may not require a fixation to the post and/or fabric adjacent thereto and can simply be maintained in its position on the post due to the fact that an attaching ring or article through the post aperture will prevent the washer from falling off. The washer can, however, also be affixed to the grommet structure and/or the belt, fabric, etc. of the article to which the grommet is attached. Various adhesives, riveting structures, threaded connections, etc., are also possible in order to achieve securement of the present invention to a desired article.

IN THE CLAIMS:

Claim 1 has been amended as follows:

1. (Once Amended) A [key ring holder] device for attaching one or more items thereto, comprising,
- an extended post having at least one aperture running transversely therethrough;[,]
- said post operatively connected to a shoulder, whereby when said device is affixed
- 5 to a desired article having: (i) an interior side facing toward an interior volume defined substantially by said desired article, said interior volume for placing one or more body portions or objects therein, and (ii) an exterior side facing substantially away from the interior volume, wherein [such that] said shoulder is positioned on said interior side, and said extended post includes at least an outwardly extending portion that extends
- 10 outwardly from [is extended to] said exterior side;[,]
- a first portion, connecting between at least a portion of said shoulder and said outwardly extending portion, for supporting said device on said desired article, wherein a user of said device can reversibly attach different items to said device by inserting for each of said different items an attachment in said aperture provided in said outwardly
- 15 extending portion.

Claim 9 has been amended as follows:

9. (Amended) The device as set forth in Claim 1, wherein said shoulder has a cavity provided therein which permits said shoulder to fit over a button included as part of said desired article.

Claim 10 has been amended as follows:

10. (Amended) A [key ring holder] device for attaching one or more items thereto, comprising:
- an extended post having a length and at least one aperture running transversely of said length [there through];

5 a shoulder having [a] first and second opposed surfaces [center] and being
operatively connected to said post, wherein said post includes a portion that extends
outwardly from at least said first surface and said aperture is on said outwardly extending
portion of said post], said shoulder having a generally circular shape and having said post
connected at about said center of said shoulder, said post having a length approximately
10 the same as said diameter of said shoulder];

a contact portion for contacting a desired article so that said device is supported
on said desired article, said contact portion including at least part of said first surface for
contacting said desired article and wherein said desired article supports said device when
one of (a) and (b) following hold:

15 (a) said contact portion includes a portion of said length extending through said
desired article wherein said article supports said device regardless of an orientation of
said desired article about said length, and

 (b) said contact portion includes at least a portion of said second surface such that
a portion of desired article is secured between said portion of said first surface and said
20 portion of said second surface;

wherein a user can reversibly attach different items to said device by inserting for
each of said different items a corresponding attachment in said aperture;

wherein said desired article is portable with the user and includes at least a portion
which conforms to a part of the user's body contacting said desired article.

Claims 11-19 have been added.